



UNITED STATES PATENT AND TRADEMARK OFFICE

UNITED STATES DEPARTMENT OF COMMERCE
United States Patent and Trademark Office
Address: COMMISSIONER FOR PATENTS
P.O. Box 1450
Alexandria, Virginia 22313-1450
www.uspto.gov

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/629,335	07/29/2003	Joachim Banik	076565-0129	6323

7590

10/05/2005

Scott M. Day
Foley & Lardner
Suite 3800
777 East Wisconsin Avenue
Milwaukee, WI 53202-5306

EXAMINER

SMALLEY, JAMES N

ART UNIT PAPER NUMBER

3727

DATE MAILED: 10/05/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

10/629,335

Applicant(s)

BANIK ET AL.

Examiner

James N. Smalley

Art Unit

3727

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☐ Responsive to communication(s) filed on ____.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-38 is/are pending in the application.
- 4a) Of the above claim(s) ____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) ____ is/are allowed.
- 6) ☒ Claim(s) 1-38 is/are rejected.
- 7) ☐ Claim(s) ____ is/are objected to.
- 8) ☐ Claim(s) ____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 29 July 2003 is/are: a) ☐ accepted or b) ☒ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
 - ☐ Certified copies of the priority documents have been received in Application No. ____.
 - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | Paper No(s)/Mail Date. ____ |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| Paper No(s)/Mail Date <u>01/02/2004</u> | 6) <input type="checkbox"/> Other: ____ |

DETAILED ACTION

Drawings

1. The drawings are objected to under 37 CFR 1.83(a). The drawings must show every feature of the invention specified in the claims. Therefore, the peripheral wall having a second surface substantially parallel to the vertical axis must be shown or the feature(s) canceled from the claim(s). Examiner notes figures 7A – 9B show various embodiments whereby all surfaces are angled with respect to the vertical axis. No new matter should be entered.

Corrected drawing sheets in compliance with 37 CFR 1.121(d) are required in reply to the Office action to avoid abandonment of the application. Any amended replacement drawing sheet should include all of the figures appearing on the immediate prior version of the sheet, even if only one figure is being amended. The figure or figure number of an amended drawing should not be labeled as “amended.” If a drawing figure is to be canceled, the appropriate figure must be removed from the replacement sheet, and where necessary, the remaining figures must be renumbered and appropriate changes made to the brief description of the several views of the drawings for consistency. Additional replacement sheets may be necessary to show the renumbering of the remaining figures. Each drawing sheet submitted after the filing date of an application must be labeled in the top margin as either “Replacement Sheet” or “New Sheet” pursuant to 37 CFR 1.121(d). If the changes are not accepted by the examiner, the applicant will be notified and informed of any required corrective action in the next Office action. The objection to the drawings will not be held in abeyance.

Claim Rejections - 35 USC § 112

2. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

3. Claims 7, 20, 30 and 37 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

Art Unit: 3727

Claims 7, 20 and 37 limit the peripheral wall having a second surface substantially parallel to the vertical axis. However, all figures show the surfaces angled with respect to the vertical axis, and Specification appears to teach away from the claimed feature.

The preamble of claim 30 is drawn to a "method" while depending from an independent claim drawn to a "container."

Claim Rejections - 35 USC § 102

4. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

5. Claims 1-3, 10-11, 13-14, 16-19, 22-34 and 38 are rejected under 35 U.S.C. 102(b) as being anticipated by Hoselton US 4,165,020.

Hoselton '020 teaches a container and lid, comprising a peripheral edge (25) with bulge (28), and a peripheral wall (24b) with a first surface angled toward the peripheral edge. The container is capable of being used in the intended manner, i.e. as a container for cosmetics or volatile compounds. It has been held that a recitation with respect to the manner in which a claimed apparatus is intended to be employed does not differentiate the claimed apparatus from a prior art apparatus satisfying the claimed structural limitations. *Ex parte Masham*, 2 USPQ2d 1647 (1987).

Claim Rejections - 35 USC § 103

6. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Art Unit: 3727

7. Claims 1-38 are rejected under 35 U.S.C. 103(a) as being unpatentable over Davis et al. US 5,842,486 in view of Hoselton US 4,165,020.

Davis '486 teaches a container for cosmetics, comprising a first (24) and second section (26) joined by a living hinge (28), a peripheral edge with a bulge (54), and a peripheral wall (44), disposed in an outer shell (12) and (14).

Davis '486 does not teach the peripheral wall having a first surface angled toward the peripheral edge.

Hoselton '020 teaches a lid for sealing engagement with a container, comprising a peripheral edge (25), and a peripheral wall (24b) with a first surface angled toward the peripheral edge. In col. 3, lines 48-51, Hoselton '020 teaches the wall portion (24b) is flexed inwardly, creating a seal against wall (15). It would be clear to one having ordinary skill that the radial outward disposition of the wall creates a bias, which tends to force the flange against the wall (15).

It would have been obvious to one having ordinary skill in the art at the time the invention was made to modify the peripheral wall of Davis '486, forming it to extend toward the peripheral edge, as taught by Hoselton '020, motivated by the benefit of providing a biasing force, pressing the wall against the container flange for sealing contact.

Regarding claims 5, 6, 8, 21, and 35-36, Davis '486, as modified, fails to explicitly disclose the angle of the peripheral wall with respect to the vertical axis.

Regarding claim 15, it has been held that rearranging parts of an invention involves only routine skill in the art. *In re Japikse*, 86 USPQ 70.

8. Claims 1-38 are rejected under 35 U.S.C. 103(a) as being unpatentable over Davis et al. US 5,842,486 in view of Hackwell et al. US 4,347,943.

Davis '486 teaches a container for cosmetics, comprising a first (24) and second section (26) joined by a living hinge (28), a peripheral edge with a bulge (54), and a peripheral wall (44), disposed in an outer shell (12) and (14).

Art Unit: 3727

Davis '486 does not teach the peripheral wall having a first surface angled toward the peripheral edge.

Hackwell '943 teaches a container lid with a peripheral wall (4) and teaches in col. 4, lines 6-16 the flange is angled such that it is deformed slightly inward upon contact with the container, in order to provide good sealing contact.

It would have been obvious to one having ordinary skill in the art at the time the invention was made to modify the peripheral wall of Davis '486, forming it to extend toward the peripheral edge, as taught by Hackwell '943, motivated by the benefit of providing a biasing force, pressing the wall against the container flange for sealing contact.

Regarding claims 5, 6, 8, 21, and 35-36, Davis '486, as modified, fails to explicitly disclose the angle of the peripheral wall with respect to the vertical axis.

Regarding claim 15, it has been held that rearranging parts of an invention involves only routine skill in the art. *In re Japikse*, 86 USPQ 70.

9. Claims 5-8, 15, 20-21 and 35-37 are rejected under 35 U.S.C. 103(a) as being unpatentable over Hoselton US 4,165,020.

Hoselton '020 fails to explicitly teach the angle of inclination of the peripheral wall.

It would have been obvious to one having ordinary skill in the art at the time the invention was made to modify the peripheral wall of Hoselton '020, forming it to about 5 to 25 degrees with respect to vertical, or to any other inclination, because it has been held that where the general conditions of a claim are disclosed in the prior art, discovering the optimum or workable ranges involves only routine skill in the art. *In re Aller*, 105 USPQ 233.

Regarding claim 15, it has been held that rearranging parts of an invention involves only routine skill in the art. *In re Japikse*, 86 USPQ 70.

Art Unit: 3727

Conclusion


10. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure: See attached PTO-892, citing relevant references.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to James N. Smalley whose telephone number is (571) 272-4547. The examiner can normally be reached on M-Th 9-6:30, Alternate Fri 9-5:30.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Nathan Newhouse can be reached on (571) 272-4544. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

jns


NATHAN J. NEWHOUSE
PRIMARY EXAMINER